

REMARKS

The claims have been amended to require the presence of at least one pigment in an amount sufficient to provide a coloring effect upon application. Support for this amendment exists throughout the present specification.

Claims 70-74 have been canceled.

Claims 1-69 are currently pending, although claims 5-62, 66 and 68 have been withdrawn from consideration because multiple dependencies existed in the claims. Applicants have amended the claims to delete multiple dependencies. Accordingly, Applicants respectfully request rejoinder of withdrawn claims at this time.

Also, the claims have been amended to place them into better condition for examination on the merits in accordance with U.S. practice.

The Office Action rejected claims 4, 63, 64, 65, 67, 69, 70, 72, 73 and 74 under 35 U.S.C. §112, second paragraph, asserting that the claims are indefinite. In view of the above non-limiting amendments to the claims, Applicants respectfully request reconsideration and withdrawal of these rejections.

The Office Action also rejected the pending claims under 35 U.S.C. § 102 as anticipated by U.S. patent 6,451,295 (“Cai”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The claimed invention relates to compositions containing at least one pigment in an amount sufficient to provide a coloring effect to keratin materials upon application as well as to methods of making or using such compositions. Cai neither teaches nor suggests makeup compositions containing at least one pigment in a result effective amount. Accordingly, Cai cannot teach or suggest the claimed invention.

Cai is directed to deodorant compositions. To the extent that these compositions can contain colorant, the colorant would presumably serve the purpose of providing a colored deodorant composition. However, given that Cai's deodorants are clear (see, Title), Cai's deodorants must contain such insignificant amounts of colorant, if any, that they do not even produce a colored product. Such clear products cannot teach or suggest the claimed invention which requires the presence of result effective amounts of pigments upon application.

Even assuming that Cai's deodorants are colored to some degree, however, such a composition would not teach or suggest the claimed compositions either. Deodorants, even if colored, are compositions which do not leave a colored mark upon application under the arms. Rather, application of deodorants results in a clear mark. This is the effect deodorant makers strive for and advertise -- "goes on clear"; "no marks," etc.

A colored deodorant which leaves an uncolored mark upon application under the arms is a far cry from the claimed invention which relates to compositions which impart color to skin, lips, eyelashes, etc. upon application, thereby beautifying the skin, lips, eyelashes.

Cai states that his deodorants can contain coloring agents along with other conventional ingredients. (Col. 24, lines 45-55). However, in the preceding paragraph, Cai states that "active materials" such as fragrances and antimicrobial agents can be incorporated into his compositions. Significantly, coloring agents are not identified as "active materials."

Similarly, at col. 22, lines 15-25, Cai defines "active ingredients" as being present in an amount sufficient to have a functional effect. Again, Cai describes fragrances and antimicrobial agents as active ingredients, but does not include coloring agents as an active agent. Rather, once again, Cai refers to coloring agents as merely being optional ingredients. (Col. 22, lines 26-34).

Clearly, Cai does not identify colorants as being acceptable active agents that can be present in result effective amounts. As a result of this omission, Cai cannot teach or suggest adding colorants as active agents, or in an amount sufficient to have a functional effect (i.e., provide color upon application). This conclusion is reinforced by Cai's purpose: to produce clear compositions.

Stated another way, Cai neither teaches nor suggests adding sufficient pigment in an acceptable manner such that the pigment will have a functional effect and provide color upon application to the skin. Thus, neither Cai cannot teach or suggest the present invention.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection under § 102.

The Office Action also rejected the pending claims under the judicially created doctrine of double patenting over claims in U.S. patent application serial no. 10/935,352. Although Applicants disagree with this rejection, solely to expedite prosecution in this case, Applicants submit herewith a Terminal Disclaimer over the '352 application. Applicants respectfully submit that the Terminal Disclaimer renders moot the double patenting rejection, and that this rejection should be withdrawn.

Application No. 10/517,390
Response to Office Action dated April 11, 2007

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel #: (703) 413-3000
Fax #: (703) 413-2220